

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Heung-sup JEONG et al.

Application No.:	10/822,004	Group Art Unit:	2852
Filed:	April 12, 2004	Examiner	Grainger, Quana Mashell
Customer No.:	38209	Confirmation No.	1588

For: ELECTROPHOTOGRAPHIC PRINTER HAVING REMOVABLE
PHOTOSENSITIVE DRUM UNIT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement mailed September 8, 2006, Applicants provisionally elect Group I, claims 1-18, with traverse. For at least the reasons discussed below, Applicants respectfully submit that all of claims 1-27 and 29-39 should be rejoined and examined together.

Claim 30 has not been assigned to any of Groups I-V. However, because claim 30 depends from claim 26, which has been assigned to Group II, Applicants assume that the Examiner intended to assign claim 30 to Group II. Accordingly, the restriction of claim 30 is addressed below based on claim 30 being assigned to Group II along with claim 26.

A. Group II (including claim 30) should be rejoined to and examined with Group I

The Examiner asserts that it would be burdensome to examine claims 19-27, 29, and 30 of Group II along with claims 1-18 of elected Group I. However, the Examiner has already examined claims 19-24 in three previous Office Actions, i.e., Office Actions dated June 28, 2005, November 3, 2005, and March 23, 2006. Similarly, the Examiner has already examined claims 25-27 in the Office Action dated March 23, 2006. Moreover, claims 29 and 30 depend from claim 26, which the Examiner has already examined in the Office Action dated March 23, 2006.

Because the Examiner has already examined claims 1-27, and because claims 29 and 30 depend from previously-examined claim 26, Applicants respectfully submit that the continued search and examination of all of claims 1-27, 29, and 30 can be made without placing a burden on the Examiner. See MPEP §803, which states that: "if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions" (emphasis added). Applicants respectfully submit that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Accordingly, reconsideration and withdrawal of the Restriction Requirement with respect to Group II (claims 19-27, 29, and 30) are respectfully requested.

B. Group V should be rejoined to and examined with Groups I

The Examiner asserts that it would be burdensome to examine claims 35-39 of Group V along with claims 1-18 of elected Group I, because the claims of Group V are directed to a sub-combination that has a separate utility from Group I. In particular, citing MPEP §806.05(d), the Examiner asserts that examining both of Groups I and V would be burdensome because Group V encompasses "rails for inserting the developing device, the intermediate transfer member, [and] the other mountable units ... in an image forming device that does not position the intermediate transfer member above the photosensitive member."

However, MPEP §806.05(d) states that "the Examiner must show, by way of example, that one of the sub-combinations has utility other than in the disclosed combination" (emphasis added). Applicants respectfully submit that the Examiner has provided no examples of the purported other use, and instead merely provides a conclusory statement that other uses are possible. Because the Examiner has provided no examples of the purported other use, as required by MPEP §806.05(d), Applicants respectfully submit that restriction between Group V and elected Group I is improper and should be withdrawn.

Furthermore, as discussed above, Group II must be rejoined to and examined with elected Group I, because the continued examination of the claims of Group II would not place a serious burden on the Examiner. See MPEP §803. In view of the rejoinder of Groups I and II, the examined claims would not be limited to an image forming device that does not position the intermediate transfer member above the photosensitive member. Thus, the Examiner's assertion that Group V is a sub-combination that has a separate utility from the examined/elected claims would be improper because the examined claims (i.e., the claims of Groups I and II) would encompass "rails for inserting the developing device, the intermediate transfer member, [and] the other mountable units ... in an image forming device that does not position the intermediate transfer member above the photosensitive member." Because Group II must be rejoined to and examined

with Group I, and because Group V does not have a separate utility from the combination of Groups I and II, Applicants respectfully submit that restriction between Group V and elected Group I and Group II is improper and should be withdrawn.

Moreover, Applicants respectfully submit that the subject matter of Group V and elected Group I is sufficiently related that a thorough search for the subject matter of Group I would encompass a search for the subject matter of Group V. Thus, Applicants respectfully submitted that for this reasons also, the search and examination of all of claims 1-18 and 35-39 could be made without serious burden. As indicated above, MPEP §803 states that if the search and examination of all the claims in an application can be made without placing a serious burden on the Examiner, the Examiner must examine them on the merits. It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

Accordingly, reconsideration and withdrawal of the Restriction Requirement with respect to Group V (claims 35-39) are respectfully requested.

C. Groups III and IV should be rejoined to and examined with Group I

Applicants respectfully submit that the subject matter of Groups II and IV and elected Group I is sufficiently related that a thorough search for the subject matter of Group I would encompass a search for the subject matter of Groups III and IV. Thus, Applicants respectfully submitted that the search and examination of all of claims 1-18 and 31-34 could be made without serious burden. As indicated above, MPEP §803 states that if the search and examination of all the claims in an application can be made without placing a burden on the Examiner, the Examiner must examine them on the merits. It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

Accordingly, reconsideration and withdrawal of the Restriction Requirement with respect to Groups III (claims 31 and 32) and IV (claims 33 and 34) are respectfully requested.

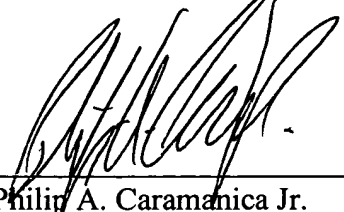
D. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement.

Respectfully submitted,

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